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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,794	12/16/2005	Kimiyoichi Machii	029267.56376US	4519
23911 7590 02/28/2011 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER MANCHO, RONNIE M	
			ART UNIT 3664	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,794

Applicant(s)

MACHIII ET AL.

Examiner

RONNIE MANCHO

Art Unit

3664

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22, 25, 26 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22, 25, 26, 34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/06/10 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25, 17-22, 26, 34, 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Newly amended claim 25 recites, "guide information containing guide point data". Applicant's published specification at section 0054 indicates that the claimed, "guide point data" constitutes "offset data for enlarged intersection area map data AND audio data". The meaning of "audio data" is well known in the art; however the meaning of "offset data for enlarged intersection area map data" is not known or even provided in applicant's disclosure. As such the

newly amended claims do not provide support for an enabling disclosure under 112 first paragraph.

Steps (c) and (e) of claim 25 are further rejected for not being enabled in the specification because of the recitation of "guide information" which interpreted to be the rejected " guide point data" as disclosed in sec 0054 of the specification.

The dependent claims are rejected for depending on a rejected base claim.

5. Claims 25, 17-22, 26, 34, 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 25 has been amended to read:

"(d) a step in which the information distribution center transmits to the information terminal all of the route information for the recommended route contained in a result of the route search calculation at once, the first piece of the guide information after the transmission of all of the route information, and the second piece of the guide information after the transmission of the first piece of the guide information separately from the first piece of the guide information;"

There is no support in the original disclosure for the claimed limitations.

This is new matter.

The dependent claims are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25, 26, 34, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (6314369).

REMARK: Since applicant has no support for the newly amended claims, the above claims have been rejected based on interpretation of the contents of the specification and drawings.

Regarding claim 25, Ito et al (abstract; figs. 12-33) discloses a route guidance method for providing route guidance by exchanging information related to a recommended route from a start point to a destination (col. 13, lines 20-36; col. 25, lines 64 to col. 26, lines 14) between an information terminal 100 and an information distribution center 150, comprising:

(a) a step in which the information terminal 100 transmits information indicating the start point and the destination to the information distribution center 150 (col. 13, lines 20-36; col. 25, lines 64 to col. 26, lines 14);

(b) a step in which the information distribution center 100 obtains route guide information including route information containing nodes (nodes; col. 36, lines 14-20; road index data, road length, road size, road number, road image, etc; col. 29, lines 29-44; col. 36, lines 13-19) representing the recommended route and guide information containing guide point data (e.g. intersections C0, C1, C2, etc, segmented data; col. 28, lines 21-39; voice data for travelling

direction, intersection data, guidance marks; col. 36, lines 21-29) for the recommended route, by which a driver is guided at a guide point for the recommended route, through a route search calculation, the guide information including at least a guidance for advancing direction at the guide point (voice data for travelling direction, intersection data, guidance marks; col. 36, lines 21-29) on the recommended route;

(c) a step in which the information distribution center 100 extracts a first piece of the guide information (see segmented data including first piece B2; col. 29, lines 9-28; fig. 16) for an area of the recommended route near the start point with a remaining portion of the guide information for a remaining area of the recommended route being defined as a second piece of the guide information (see segmented data including second piece B3; col. 29, lines 9-28; fig. 16, figs. 15A-E); and

(d) a step in which the information distribution center 150 transmits to the information terminal 100 the route information contained in a result of the route search calculation, the first piece of the guide information (see segmented data including first piece B2; col. 29, lines 9-28; fig. 16) after the transmission of the route information (nodes; col. 36, lines 14-20; road index data, road length, road size, road number, road image, etc; col. 29, lines 29-44; col. 36, lines 13-19; figs. 16, 26), and the second piece of the guide information (see segmented data including second piece B3; col. 29, lines 9-28; fig. 16, figs. 15A-E) after the transmission of the first piece of the guide information separately from the first piece (see segmented data including first piece B2; col. 29, lines 9-28; fig. 16) of the guide information; and

(e) a step in which the information terminal starts the route guidance (col. 28, lines 51-59) upon receiving the route information and the first piece of the guide information (see

segmented data including first piece B2; col. 29, lines 9-28; fig. 16) from the information distribution center 100.

The prior art Ito teaches that embodiments of figs 24-33 could be combined with embodiments of figs. 12-23. Therefore it would have been obvious to one of ordinary skill in the art to combine the embodiments depending on route configurations and a needed capacity a database (col. 35, lines 31-47; lines 66 to col. 36, lines 29) and amount of data required for route guidance.

Regarding claim 26, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 25, wherein the guide information includes a guidance for advancing direction at each guide point on the recommended route (see e.g. voice data for travelling direction, intersection data, guidance marks; col. 36, lines 21-29).

Regarding claim 34, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 25, wherein the guide point data includes at least one of enlarged map data and audio data (e.g. intersections C0, C1, C2, etc, segmented data; col. 28, lines 21-39; voice data for travelling direction, intersection data, guidance marks; col. 36, lines 21-29).

Regarding claim 36, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 25, wherein the step (c) is performed when a distance between the starting point and the destination is not smaller than a predetermined value (col. 29, lines 9-28; fig. 16, figs. 15A-E). Ito determines the length or distance between start and destination. The distance between the start and destination as taught by Ito is obviously greater than zero i.e. it is not smaller than zero. Thus it would be obvious to one having ordinary skill in the art at the time the invention was made that the distance taught by Ito is not smaller than a predetermined value.

8. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (6314369) in view of Ahrens et al (2002/0010542) and further in view of Bruner et al (7243134).

REMARK: Since applicant has no support for the newly amended claims, the above claims have been rejected based on interpretation of the contents of the specification and drawings.

Regarding claim 17, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 25, further comprising:

(iii) a step in which, the information distribution center receives the request (col. 13, lines 20-36; col. 25, lines 64 to col. 26, lines 14).

Ito did not particularly disclose that a user is informed of the download period required to download route information. However, Ahrens et al (section 0113) teaches of (i) a step in which a user is informed of an estimated period of time required for downloading route guide information determined based upon a physical quantity indicating a data size of the route guide information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito as taught by Ahrens for the purpose of effectively downloading navigation data for storage media.

Ito and Ahrens disclose steps (i) and (iii) as indicated above but did not disclose that route installments are transmitted according to an instruction by the user. However, Bruner teaches of a route guidance method including (ii) a step in which an information terminal 22 transmits a request to an information distribution center 24 to transmit the route guide information in installments (S1, according to an instruction by the user (col. 10, lines 17-37; col. 11, lines 57 to col. 12, lines 4, lines 31-40). Based on a user's preference, the user sets a size

limit of data memory for downloading data. If the memory size set by the user is smaller than the size of route data to be transmitted, the information terminal 22 will transmit a request to the information distribution center 24 to transmit the route guide information in installments. On the other hand, if the memory size set by the user is larger than the size of route data to be transmitted, the information terminal 22 will transmit a request to the information distribution center 24 to transmit the route guide information as a whole file.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito and Ahrens as taught by Bruner for the purpose of effectively downloading navigation data to limit costs, save memory capacity, and to obey regulation (Bruner, col. 14, lines 59-67; col. 15, lines 45-67). Bruner further discloses that embodiments in its disclosure are combinable, thus it would be obvious to one of ordinary skill in the art to combine the embodiments as taught.

Regarding claim 18, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 17, wherein the guide information includes at least a guidance for advancing direction at each guide point on the recommended route (see e.g. voice data for travelling direction, intersection data, guidance marks; col. 36, lines 21-29).

Regarding claim 19, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 18, wherein the portion of the guide information corresponding to the area near the start point includes guide information for a block extending from the start point to a next guide point (see fig. 15; col. 28, lines 51-59).

Regarding claim 20, Ito as modified by Ahrens disclose the route guidance method according to claim 17, wherein the data size of the route guide information is a data size of the

guide information or a number of guide points contained in the guide information (Ito discloses size of route guide in fig. 17 and guide points e.g. landmark in fig. 18). Thus it would be obvious to one of ordinary skill in the art.

Regarding claim 21, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 17, wherein after starting the route guidance, the information terminal transmits to the information distribution center a request for the second piece of the guide information, and the information distribution center extracts and transmits the second piece of the guide information (see figs. 16, 20, 21; col. 30, lines 60 to col. 31, lines 13, lines 58 to col. 32 lines 12). The embodiments in Ito are combinable taught, thus it would be obvious to one having ordinary skill in the art.

Regarding claim 22, Ito et al (abstract; figs. 12-33) discloses the route guidance method according to claim 21, wherein each time the request for the second piece of the guide information is received, the information distribution center transmits guide information extracted in a unit corresponding to a guide point to the information terminal (see figs. 16, 20, 21; col. 30, lines 60 to col. 31, lines 13, lines 58 to col. 32 lines 12). The embodiments in Ito are combinable taught, thus it would be obvious to one having ordinary skill in the art.

Response to Arguments

9. Applicant's arguments filed 12/6/10 have been fully considered but they are not persuasive.

Applicant has amended the claims adding new limitations therein. However, applicant does not show support for the newly added limitations in the claims. Applicant argues that the

prior art does not disclose the newly amended limitations. The examiner respectfully disagrees because the amended claims do not themselves provide an enabling disclosure.

10. Newly amended claim 25 recites, “guide information containing guide point data”.

Applicant’s published specification at section 0054 indicates that the claimed, “guide point data” constitutes “offset data for enlarged intersection area map data AND audio data”. The meaning of “audio data” is well known in the art; however the meaning of “offset data for enlarged intersection area map data” is not known or even provided in applicant's disclosure. As such the newly amended claims do not provide support for an enabling disclosure under 112 first paragraph.

Steps (c) and (e) of claim 25 are further rejected for not being enabled in the specification because of the recitation of “guide information” which interpreted to be the rejected “guide point data” as disclosed in sec 0054 of the specification.

The dependent claims are rejected for depending on a rejected base claim.

11. Further, independent claim 25 has been amended to read:

“(d) a step in which the information distribution center transmits to the information terminal all of the route information for the recommended route contained in a result of the route search calculation at once, the first piece of the guide information after the transmission of all of the route information, and the second piece of the guide information after the transmission of the first piece of the guide information separately from the first piece of the guide information;”.

There is no support in the original disclosure for the claimed limitations.

This is new matter.

The dependent claims are rejected for depending on a rejected base claim.

Since applicant has no support for the newly amended claims, the above claims have been rejected based on interpretation of the contents of the specification and drawings.

It is believed that the rejections are proper. They thus stand.

Communication

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONNIE MANCHO whose telephone number is (571)272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Khoi can be reached on 571-272-6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Primary Examiner
Art Unit 3664

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